



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Keiji OSAWA

Group Art Unit: 2872

Application No.: 10/653,223

Examiner: R. Shafer

Filed: September 3, 2003

Docket No.: 103173.04

For: OPTICAL FILTER AND OPTICAL DEVICE PROVIDED WITH THIS
OPTICAL FILTER

**REQUEST FOR RECONSIDERATION
AND
RESPONSE TO ELECTION OF SPECIES REQUIREMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the December 14, 2004 Office Action, the period being extended by the attached Petition for Extension of Time, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-20 are pending in this application. Reconsideration based on the following remarks is respectfully requested.

The courtesies extended to Applicant's representative by Examiner Shafer at the telephone interview held May 11, 2005, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicant's record of the interview.

I. Election of Species Requirement

In reply to the December 14, 2004 Election of Species Requirement, Applicant provisionally elects, Species B, Fig. 6, with traverse. Applicant asserts that all claims 1-20 read on elected species.

It is also respectfully submitted that the subject matter of all species is sufficiently related that a thorough search for the subject matter of any one species would encompass a search for the subject matter of the remaining species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Election of Species Requirement is respectfully requested.

II. Allowable Subject Matter

Applicant appreciates the Office Action's indication that claims 4-6 are allowed.

III. The Specification Satisfies 35 U.S.C. §112, First Paragraph

The Office Action objects to the specification alleging that the specification includes unclear terms. Specifically, the Office Action asserts that on page 27, line 1, the recitation "th" should be changed to "the", on page 18, line 1, the recitation "sinc" should be changed to "since", and on page 30, line 1, the recitation "th phas" should be changed to read "the phase." This objection is respectfully traversed.

Applicant notes that it appears that the objections of the specification are due to a poorly scanned copy of the specification. As a courtesy to the Examiner, Applicant herein

encloses the original specification as filed on September 3, 2003. Withdrawal of the objection is respectfully requested.

IV. Double Patenting Rejections

A. Claims 1, 7, 10 and 16

The Office Action rejects claims 1, 7, 10 and 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,778,325 ('325). This rejection is respectfully traversed.

As agreed during the May 11 telephone interview, this double patenting rejection is improper. Claims 1, 7, 10 and 16 are patentably distinct from each other as evidenced by the July 29, 2003 Quayle Action for Application No. 10/119,702, now U.S. Patent No. 6,778,325. Specifically, the July 29, 2003 Quayle Action states that "newly submitted claims 6-25 are directed to an invention that is independent or distinct from the invention originally claimed." Claims 6-25 from Application No. 10/119,702 correspond to claims 1-20 of the instant application. Withdrawal of the rejection is respectfully requested.

B. Claims 1-3 and 10-12

The Office Action rejects claims 1-3 and 10-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 3 of U.S. Patent No. 6,650,474. This rejection is respectfully traversed.

Applicant respectfully submits the attached Terminal Disclaimer. This rejection is now moot.

C. Claims 1-3 and 10-15

The Office Action rejects claims 1-3 and 10-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,327,085. This rejection is respectfully traversed.

Applicant respectfully submits the attached Terminal Disclaimer. Thus, this rejection is now moot.

D. Claims 8, 9 and 17-20

The Office Action rejects claims 8, 9 and 17-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,778,325 in view of 5,781,236 to Shinbori et al. This rejection is respectfully traversed.

For the reasons discussed above with regard to the rejection of claims 1, 7, 10 and 16 under the judicially created doctrine of obviousness-type double patenting over claim 1 of '325, and as agreed during the telephone interview, this rejection is also improper.

Withdrawal of the rejection is respectfully requested.

V. The Claims Define Patentable Subject Matter

A. 35 U.S.C. §102(b) Rejection

The Office Action rejects claim 10 under 35 U.S.C. §102(b) as being anticipated by JP 10-54960 to Saito. This rejection is respectfully traversed.

Claim 10 is not anticipated by Saito. Saito does not disclose an optical filter that includes "a first birefringent plate and a second birefringent plate ...; and a phase plate ..., wherein the first birefringent plate and the second birefringent plate are thinner than the phase plate," as recited in claim 10.

The Office Action asserts that Saito disclose an optical filter that includes a plurality of birefringent plates [(1a, 1b), (85, 86)] for spatially dividing incident light, and at least one phase plate [(3), (84)]. The Office Action further asserts that the birefringent plates [(1a, 1b), (85, 86)] are thinner than the phase plate [(3), (84)]. See, e.g., Saito, Figs. 4(A) and 11(B). These assertions are respectfully traversed.

Regarding Fig. 4, Saito only discloses that a square-shaped 45-degree separation birefringent plate 3 with the thickness of $T_x \sqrt{2}$ is placed between a horizontal separation

birefringent plate 1a and a vertical separation birefringent plate 1b so as to achieve the laminated structure. See e.g., Saito, paragraph [0029]. Further, regarding Fig. 11(A), Saito only discloses that a quarter-wave plate 83 is placed between a horizontal separation birefringent plate 81, and a vertical separation birefringent plate 82 with the thicknesses T being equal to each other. Regarding Fig. 11(B), Saito discloses that on both sides of a horizontal separation birefringent plate 84 with the thickness T, two 45-degree separation birefringent plates 85 and 86 with separation directions being different from each other by 90 degrees and the thicknesses being $T \times \sqrt{2}$ are provided. See e.g., Saito, paragraph [0005].

That is, Saito does not disclose that the first birefringent plate and the second birefringent plate are thinner than the phase plate as recited in claim 10. Nowhere does Saito disclose this feature. Saito only discloses three birefringent plates in Figs. 4(A) and 11(B). Further, Saito does not disclose the thickness of the birefringent plates and the quarter-wave plate in Fig. 11(A). Thus, Saito does not disclose the optical filter recited in claim 10.

Claim 10 is not anticipated by Saito. Withdrawal of this rejection is respectfully requested.

B. 35 U.S.C. §103(a) Rejection

The Office Action rejects claims 11 and 12 under 35 U.S.C. §103(a) as being unpatentable over Saito in view of Shinbori or U.S. Patent No. 5,940,127 to Nakajima. This rejection is respectfully traversed.

Claims 11 and 12 depend from claim 10. Thus, for at least the reasons discussed above with regard to claim 10, claims 11 and 12 are patentable over Saito. Further, Shimbori and Nakajima do not remedy the deficiency of Saito. None of these references teach or suggest "a phase wherein the first birefringent plate and the second birefringent plate are thinner than the phase plate," as recited in claim 10. Thus, claims 11 and 12 would not have

been obvious over Saito in view of Shinbori or Nakajima. Withdrawal of this rejection is respectfully requested.

VI. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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MAC:RBI/cfr

Attachments:

Petition for Extension of Time
Terminal Disclaimer for U.S. Patent No. 6,665,474
Terminal Disclaimer for U.S. Patent No. 6,327,085
Original Specification filed September 3, 2003

Date: May 16, 2005

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